

REMARKS:

- 1) Referring to item 10) of the Office Action Summary, the Examiner is respectfully requested to accept the Formal Drawings originally filed with this application on March 1, 2002.
- 2) On April 13 and 15, 2005, the Examiner and the undersigned attorney conducted a Telephone Interview, in which the Examiner suggested certain amendments to place this application into allowable condition. As instructions from the applicant could not be obtained in time to avoid the issuance of a further Office Action, the Examiner issued the present Office Action which was then formally mailed on April 21, 2005. The Examiner's suggestions are appreciated and have been adopted. Namely, as will be detailed below, the claims have been amended to recite a "lithium primary battery," prior claims 6 to 10 have been reintroduced in new claims, asserted new matter relating to "an initial as-manufactured condition" has been avoided, and the title and specification have been amended at pages 1 and 2 for express description support of the term "lithium primary battery." As the suggestions and proposed amendments discussed in the Telephone Interview have now been adopted, it is expected that the application should now be in allowable condition.
- 3) The title of the invention and the written description at page 2 lines 4 to 6 have been amended to expressly support the claim terminology "lithium primary battery." This was suggested by the Examiner in the Telephone Interview, which is appreciated and has

been adopted. In the Telephone Interview, the Examiner agreed that this amendment does not introduce new matter, because a person of ordinary skill in the art can readily understand that the originally disclosed battery actually is a primary battery, even if that term was not expressly stated. See the discussion in remarks section 5) at pages 7 and 8 of the prior Response of September 29, 2004. Also see the last sentence of the Examiner's Statement of Allowable Subject Matter at the middle of page 4 of the prior Office Action of December 23, 2004. Thus, entry of the present amendments in the specification is respectfully requested.

4) The claims have been amended as follows.

Claims 1 to 4 have each been amended to expressly recite a "lithium primary battery." This clarification merely expressly recites what was originally inherently understood from the disclosure, and does not introduce any new matter, as discussed above.

New claims 12 to 16 have been added, depending from claim 1. These claims are based on prior claims 6 to 10 from the Response of September 29, 2004, except that they have been clarified as relating to a "lithium primary battery" and that the asserted new matter relating to "an initial as-manufactured condition" has been omitted and avoided. In the Telephone Interview, the Examiner pointed out that this prior terminology was the crux of the prior new matter objection, that the objection could be avoided by omitting this terminology, and that this terminology is not necessary for properly defining the invention.

New independent claim 17 is based on prior claim 11 of the Response of September 29, 2004, except that claim 17 has been clarified to recite a "lithium primary battery" and to avoid reciting "an initially charged condition ..." similarly as discussed above. Thus, new claim 17 avoids any previously asserted new matter.

The new claims 12 to 17 are further supported in the portions of the original specification as pointed out for prior claims 6 to 11 in the table at the top of page 7 of the Response of September 29, 2004.

Entry and consideration of the claim amendments and the new claims are respectfully requested.

- 5) Referring to pages 2 to 4 of the Office Action, the rejection of claims 1 to 4 as obvious over US Patent 5,578,395 (Yoshimura et al.) in view of US Patent 5,114,811 (Ebel et al.) is respectfully traversed.

Claims 1 to 4 have now been amended to expressly recite a "lithium primary battery" comprising certain specified compositions and other features of a positive electrode and of a negative electrode.

As acknowledged by the Examiner in the above mentioned Telephone Interview, the prior art does not disclose and would not have suggested a lithium primary battery having such a combination of features. In this regard, also see the top of page 4 of the present Office Action, where the Examiner expressly notes that this rejection is applicable because "claim 1 does not limit the claimed battery as a primary battery." After the

present amendment, claim 1 does limit the claimed battery as a primary battery, so that the rejection no longer applies.

Particularly, Yoshimura et al. do not disclose the pertinent features of a positive electrode as a characteristic of a lithium primary battery. To the contrary, the Yoshimura et al. disclosure expressly relates to a lithium secondary battery. Such a disclosure would not have provided any suggestions toward using the pertinent composition for a positive electrode of a primary battery, in view of the significant compositional, functional, and operational differences between primary batteries and secondary batteries (see the discussion at pages 7 and 8 of the prior Response of September 29, 2004).

Thus, even a combination of Yoshimura et al. (regarding a lithium secondary battery) and Ebel et al. (regarding composition of a negative electrode) would not have made the presently claimed invention obvious, because the pertinent positive electrode composition for a lithium primary battery would not have been suggested.

For the above reasons, the Examiner is respectfully requested to withdraw the rejection of claims 1 to 4 as obvious over Yoshimura et al. in view of Ebel et al.

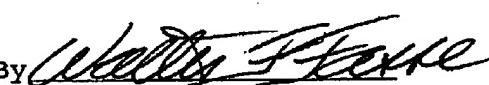
- 6) The new claims 12 to 16 depend from claim 1, and should thus be allowable already in view of their dependence.
- 7) New independent claim 17 is also directed to a lithium primary battery having a positive electrode that comprises manganese dioxide and 0.1 to 3 weight percent of boron. For the same

reasons discussed above in connection with claim 1, such features in a lithium primary battery would not have been suggested by the prior art. Thus, claim 17 should also be allowable.

- 8) Favorable reconsideration and allowance of the application, including all present claims 1 to 4 and 12 to 17, are respectfully requested.

Respectfully submitted,  
Seiji YOSHIMURA et al.  
Applicant

WFF:kd/4321  
Enclosures:  
Term Extension,  
Form PTO-2038

By   
Walter F. Fasse  
Patent Attorney  
Reg. No.: 36132  
Tel. 207-862-4671  
Fax. 207-862-4681  
P. O. Box 726  
Hampden, ME 04444-0726

CERTIFICATE OF FAX TRANSMISSION:

I hereby certify that this correspondence with all indicated enclosures is being transmitted by telefax to (571) 273-8300 on the date indicated below, and is addressed to: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

 9/20/05  
Name: Walter F. Fasse - Date: September 20, 2005